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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,657	06/19/2000	Donald E. Ackley	254/302	4315

34263 7590 03/26/2003

O'MELVENY & MEYERS  
114 PACIFICA, SUITE 100  
IRVINE, CA 92618

EXAMINER
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MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/596,657

Applicant(s)

Ackley et al.

Examiner  
Ardin Marschel

Art Unit  
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 12, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39, 40, 42, 46-49, 51-60, and 115-117 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39, 40, 42, 46-49, 51-60, and 115-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Upon reconsideration, the indication of allowability of certain claims is hereby withdrawn.

Applicants' arguments, filed 6/12/02, have been fully considered but they are not deemed to be fully persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Upon reconsideration, the following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### DRAWINGS

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". It is noted that a PTO Form 948 is mailed herewith. Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

#### VAGUENESS AND INDEFINITENESS

Claims 39, 40, 42, 46-49, 51-60, and 115-117 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 42 confusingly depends from a canceled claim, that is, depends from claim 41 and thus is unclear what actual limitations are present in claim 42. Clarification via clearer claim wording is requested.

Claim 40, last 2 lines, contains the limitation that the first and second collection electrodes are disposed at "substantially opposite ends". The antecedent basis of what ends are meant is vague and indefinite. Are said "ends" relative to the substrate? Are they relative to the array region? Are they "ends" of the flow cell footprint? Clarification via clearer claim wording is requested.

In claim 39, line 5, a "region" is set forth but without defining the antecedent basis for what region is meant. Is it a region on the substrate? Is it a region on the support? What is the relationship between said region, substrate, and support? Clarification via clearer claim wording is requested. This unclarity exists in claim 55 also. Claims which are directly or indirectly dependent from claims 39 or 55 are also included as rejected due to said dependence.

Claim 39 is vague and indefinite in that the last 4 lines therein define a proportion relating to the flow cell footprint which is 40%, but wherein the 40% evaluation is unclear as to

what is calculated in order to meet this limitation. Is the footprint 40% either present on the first or second collection electrode or is the footprint summed over the first and second collection electrode areas. This unclarity also specifically exists in claims 51 and 52. Clarification via clearer claim wording is requested. Claims which are directly or indirectly dependent from claim 39 are also included as rejected due to said dependence.

Claim 46 is vague and indefinite as to the cooperativity as to location relationship of the capture sequences in the claim relative to the support, substrate, array region, etc. Similarly, claim 49 cites a focusing electrode without defining its location relationship to the support, substrate, capture sequences, etc. Clarification via clearer claim wording is requested.

Abbreviations in claims are generally vague and indefinite if not accompanied by their full name. Such an abbreviation given as "AC" is present in claim 115. Clarification via clearer claim wording is requested.

The "repulsive" and "attractive" limitations in claims 116 and 117 are relative terms which lack clarity as to being "repulsive" or "attractive" to what. It may be presumed that these limitations are relative to a charged biological material, but such a presumption is not clear and concise as required by 35

U.S.C. § 112, second paragraph. Clarification via clearer claim wording is requested.

No claim is allowed.


Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

March 24, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.